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09/880,630	06/13/2001	David Leason	3607/11483US1	5915

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EXAMINER

PEACHES, RANDY

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,630

Applicant(s)

LEASON, DAVID

Examiner

Randy Peaches

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. ***Claims 1-3, 5-8, and 13*** are rejected under 35 U.S.C. 102(e) as being as being anticipated by Weber et al (U.S. Patent Number 6,343,212).

Regarding ***claim 1***, Weber et al discloses, as referenced in column 4 lines 1-9, that in a mobile terminal, which reads on claimed “device”, that alerts a user to an incoming message, e.g. call, by activating a acoustic driver, e.g. ringer/speaker, a method for changing the mode of a mobile terminal by turning the ringer off, lowering the volume, or placing the said mobile terminal in vibration mode, which reads on claimed “shunting the acoustic driver”, comprising the step of:

- detecting the presence of broadcast system information, which reads on claimed “broadcast squelch signal”, by monitoring the said broadcast system information that arrive at the said mobile terminal from a base station, which reads on claimed “emitter”. See column 2 lines 50-63.
- automatically changing the mode of the said mobile terminal in response to detecting the said broadcast system information, step free of any communication back to said base station. See column 7 lines 3-10.

Regarding **claim 2** as claimed in **claim 1**, Weber et al discloses a method wherein the said broadcast system information originates extrinsic to the said mobile terminal. See FIGURE 5.

Regarding **claim 3** as claimed in **claim 1**, Weber et al discloses a method including that additional step of activating a vibrator to alert the user of the incoming message or call while the said broadcast system information is being detected. See column 4 and 10 lines 1-9 lines 22-35, respectfully.

Regarding **claim 5** as claimed in **claim 1**, Weber et al discloses a method wherein the detecting step comprises a processing of signals, which reads on claimed “comparing incoming signals”, depending on the structure of the signal and determining whether the signal is audible, data or a mode of change signal when the presence of a said broadcast system information is detected. See column 6 lines 37-46.

Regarding **claim 6** as claimed in **claim 1**, Weber et al discloses a method wherein the detecting step comprises processing incoming broadcast system information to extract, when present, the indication, which reads on claimed “indicium” (Latin term for “indication”), of the presence of the said mode change information contained in the said broadcast system information thereby detecting the presence of the said mode change information. See column 3 lines 20-33.

Regarding **claim 7** as claimed in **claim 1**, Weber et al discloses a method including an additional step of changing the mode of the mobile terminal, which reads on claimed “shunting the acoustic driver”, for a predetermined period of time after the said broadcast system information is detected. See column 9 lines 47-67.

Regarding **claim 8** as claimed in **claim 7**, Weber et al discloses in column 9 lines 47-67 of a method wherein the step of changing the mode of the mobile terminal, which reads on claimed “shunting the acoustic driver”, continues for a period of time after a said broadcast mode change information signal is no longer present. Weber teaches that in “other areas” a mode change information signal is broadcasted only once, at an entrance of a building for example; yet, the mode of the said mobile terminal is maintained for a period of time despite the fact that the said mobile terminal is not receiving the mode change information signal.

Regarding **claim 13**, Weber et al discloses, a said mobile terminal, which reads on claimed "electronic device", of the type which alerts a user to an incoming call, which reads on claimed "message", by connecting an alert signal to a pre-selected alert functions such as vibration mode or visual signals on a display, which reads on claimed "first and second alert devices", while the said broadcast system information is being detected, comprising:

- detecting, as disclosed in column 3 lines 20-33, step comprises processing incoming broadcast system information to extract, thereby detecting the presence of the said mode change information locally by a base station, which reads on claimed "emitter", and a generating means, as disclosed in column 4 lines 1-9, generates a mode change information, which reads on claimed "control signal", at its output when the said broadcast system information is detected;
- a control means, which reads on claimed "switch", operatively connected to the output of the detector, see FIGURE 3, to automatically direct the said detected mode changing information to a predetermined one of the said pre-selected alert functions such as vibration mode or visual signals on a display while the said broadcast system information is being detected, wherein the said mobile terminal operates free of any communications back to the said base station. See column 5 lines 50-65.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claim 4*** is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (U.S. Patent Number 6,343,212) in view of Schmidt et al (U.S. Patent Number 6,516,200 B1).

Regarding ***claim 4***, according to ***claim 1***, Weber et al discloses, as referenced in column 4 lines 1-9, that in a mobile terminal, which reads on claimed "device", that alerts a user to an incoming message, e.g. call, by activating a acoustic driver, e.g. ringer/speaker, a method for changing the mode of a mobile terminal by turning the ringer off, lowering the volume, or placing the said mobile terminal in vibration mode, which reads on claimed "shunting the acoustic driver", comprising the step of:

- detecting the presence of broadcast system information, which reads on claimed "broadcast squelch signal", by monitoring the said broadcast system information that arrive at the said mobile terminal from a base station, which reads on claimed "emitter". See column 2 lines 50-63.

- automatically changing the mode of the said mobile terminal in response to detecting the said broadcast system information, step free of any communication back to said base station. See column 7 lines 3-10.

However, Weber does not disclose a method wherein the said device is operable to access a memory and retrieve a user-set alert mode in response to an incoming message.

Schmidt et al teaches in column 11 lines 1-12, that the flexibility of the said mobile terminal allow the user to selectably pre-set alarm settings according to the incoming group call, which reads on claimed "message". Once the incoming message is detected, the said mobile unit performs accordingly by accessing a memory of the said mobile terminal, see FIGURE 2, and retrieving the user-set alert and in response to the said incoming message either allowing the said mobile terminal to use a low level vibration, a loud ring, and/or display the information on a display unit; all of which are retrieved from a memory and executed accordingly to the pre-set alert settings made by the said user.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Weber et al (U.S. Patent Number 6,343,212) to include Schmidt et al (U.S. Patent Number 6,516,200 B1) in order to incorporate a method wherein the said device is operable to access a memory and retrieve a user-set alert mode in response to an incoming message.

3. **Claims 9-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040).

Regarding **claim 9**, Weber et al discloses, as referenced in FIGURE 1, a use with a said mobile terminal which changes the mode of the said mobile terminal which is otherwise activated to alert a user to an incoming call, a base station, which reads on claimed "broadcast system", comprising:

- a generating means, which reads on claimed "generator", which outputs a mode changing information having a frequency which, when detected at the said mobile terminal, changes the mode, which reads on claimed "shunts the acoustic driver", of the said mobile terminal. See column 5 lines 36-49.
- an antenna (see FIGURE 1, column 5 lines 44-49); and
- a transmitting means, which reads on claimed "transmitter", wherein the signal is transmitted from the antenna to a predefined area, as referenced in column 5 lines 50-54, which any said mobile terminal is capable of detecting the said mode changing information from a said broadcast system information.

Although Weber et al does disclose in column 6 lines 1-4, that the said base station is comprised with elements that are necessary to operate the said base station in a telecommunication system. Weber et al does not disclose, however, the use of an amplifier in the configuration of the said base station.

Trompower teaches in column 3 lines 33-45, of an amplifier as part of the configuration of the said base station used to change the gain of the transmitter and receiver.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Weber et al (U.S. Patent Number 6,343,212) to include Trompower (U.S. Patent Number 5,924,040) to incorporate a said amplifier that is connected to the said generator's output to amplify the said broadcast signal in order to be detected by the said mobile terminal.

Regarding **claim 10**, as the above combination of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) are made, the combination according to **claim 9**, wherein the generator and the amplifier and the transmitter are housed together.

Regarding **claim 11**, as the above combination of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) are made, the combination according to **claim 10**, wherein the antenna is freely positional remote from the transmitter. See Trompower antenna 62a and transmitter 54b in FIGURE 1.

Regarding **claim 12**, as the above combination of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) are made, the combination according to **claim 9**, wherein the output of the amplifier has a variable

power level, as stated by Trompower in column 3 lines 1-14, setting such that the zone of influence can be varied with the changes in the variable power level setting.

4. **Claims 14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) and in further view of da Silva (U.S. Patent Number 6,496,703 B1).

Regarding **claim 14**, the above combination of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) are made, the combination according to **claim 10**, result in a method wherein said mobile terminal which changes the mode of the said mobile terminal which is otherwise activated to alert a user to an incoming call, a base station, which reads on claimed "broadcast system", comprising:

- a generating means, which reads on claimed "generator", which outputs a mode changing information having a frequency which, when detected at the said mobile terminal, changes the mode of the mobile terminal, which reads on claimed "shunts the acoustic driver". See column 5 lines 36-49.
- an antenna (see FIGURE 1, column 5 lines 44-49); and
- an amplifier as part of the configuration of the said base station used to change the gain of the transmitter and receiver. Trompower teaches in column 3 lines 33-45.

- a transmitting means, which reads on claimed "transmitter", wherein the signal is transmitted from the antenna so as to a predefined area, as referenced in column 5 lines 50-54, which any said mobile terminal has detected a said mode changing information.

However the combination of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) does not disclose wherein the device is a cellular telephone.

da Silva teaches in column 2 lines 10-16, that the said device may include cellular phones, beepers, pagers, portable computers, electronic personal attendants and or similar wireless devices.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) to include da Silva (U.S. Patent Number 6,496,703 B1) in order to expand the practical applications of the said mobile terminal in Weber et al to be specifically used in a cellular phone.

Regarding **claim 15**, the above combination of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) are made, the combination according to **claim 10**, result in a method wherein said mobile terminal which changes the mode of the said mobile terminal which is otherwise activated to alert a user to an incoming call, a base station, which reads on claimed "broadcast system", comprising:

- a generating means, which reads on claimed "generator", which outputs a mode changing information having a frequency which, when detected at the said mobile terminal, changes the mode of the mobile terminal, which reads on claimed "shunts the acoustic driver". See column 5 lines 36-49.
- an antenna (see FIGURE 1, column 5 lines 44-49); and
- an amplifier as part of the configuration of the said base station used to change the gain of the transmitter and receiver. Trompower teaches in column 3 lines 33-45.
- a transmitting means, which reads on claimed "transmitter", wherein the signal is transmitted from the antenna so as to a predefined area, as referenced in column 5 lines 50-54, which any said mobile terminal has detected a said mode changing information.

However the combination of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) does not disclose wherein the device is a pager.

da Silva teaches in column 2 lines 10-16, that the said device may include cellular phones, beepers, pagers, portable computers, electronic personal attendants and or similar wireless devices.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) to include da Silva

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(U.S. Patent Number 6,496,703 B1) in order to expand the practical applications of the said mobile terminal in Weber et al to be specifically used in a pager.

Regarding **claim 16**, the above combination of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) are made, the combination according to **claim 10**, result in a method wherein said mobile terminal which changes the mode of the said mobile terminal which is otherwise activated to alert a user to an incoming call, a base station, which reads on claimed "broadcast system", comprising:

- a generating means, which reads on claimed "generator", which outputs a mode changing information having a frequency which, when detected at the said mobile terminal, changes the mode of the mobile terminal, which reads on claimed "shunts the acoustic driver". See column 5 lines 36-49.
- an antenna (see FIGURE 1, column 5 lines 44-49); and
- an amplifier as part of the configuration of the said base station used to change the gain of the transmitter and receiver. Trompower teaches in column 3 lines 33-45.
- a transmitting means, which reads on claimed "transmitter", wherein the signal is transmitted from the antenna so as to a predefined area, as referenced in column 5 lines 50-54, which any said mobile terminal has detected a said mode changing information.

However the combination of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) does not disclose wherein the device is a personal digital assistant.

da Silva teaches in column 2 lines 10-16, that the said device may include cellular phones, beepers, pagers, portable computers, electronic personal attendants and or similar wireless devices.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Weber et al (U.S. Patent Number 6,343,212) in view of Trompower (U.S. Patent Number 5,924,040) to include da Silva (U.S. Patent Number 6,496,703 B1) in order to expand the practical applications of the said mobile terminal in Weber et al to be specifically used in a personal digital assistant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (703) 305-8993. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-5576.

Randy Peaches

December 23, 2003

A handwritten signature in black ink, appearing to read "Nguyen V.", with a stylized flourish at the end.

**NGUYENT.VO
PRIMARY EXAMINER**